IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	)
	)
	)
Hajime Takei et al.	) Group Art Unit: 2625
	)
Application No.: 09/970,702	) Examiner: Dillon J Murphy
	)
Filed: October 5, 2001	) Confirmation No.: 1791
	)
For: PRINTING SYSTEM, AND PRINT	)
SERVER AND COMPUTER	)
PROGRAM USED IN SAID	)
PRINTING SYSTEM	)
	)

Pre-Appeal Brief Request for Review

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection of claims 1-15 set forth in the Office Action dated November 9, 2005. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal.

Background

The claims are directed to printing systems that have an on-line printer and print server, and an off-line finishing device. The printer may be able to perform certain types of finishing operations specified in a job ticket, such as stapling, but other types of finishing operations, such as binding, may need to be performed by the off-line finishing device. To accommodate these types of print jobs, the application discloses a print server that stores information regarding the capabilities of the printer and the finishing device. Referring to Figure 6, when a job ticket is received (S201), the print server calls up the information regarding the capabilities of the printer and the finishing device (S203) and sorts the requested finishing specifics designated on the job ticket into those that can be performed by the printer and those that are to be performed by the finishing device (S204). It then sends, to the printer, the parameters for the finishing operations that are to be carried out by the printer (S205). Since the finishing device is located off-line, the print server creates

VA 863325.1

a finishing device job ticket that includes those finishing specifics that have been sorted from the original job ticket and designated for the finishing device (S206). Thereafter, the printer prints the document and performs those requested finishing operations that it is capable of doing. The document is then transferred to the off-line finishing device, along with the finishing device job ticket, to complete the remainder of the finishing operations.

The Rejections

Claims 1, 2, 4, 5, 7 and 8 are rejected under 35 U.S.C. §102, on the basis of the Hansen patent (US 6,509,974). Claims 3, 6 and 9-15 are rejected under 35 U.S.C. §103, on the basis of the Hansen patent in view of various secondary and tertiary references. Since the rejections under §103 are based upon the anticipation rejection under §102, for the sake of brevity only the anticipation rejection will be addressed in this Request.

Claim 1 recites a printing system having an on-line print server that includes a memory for storing specifications of the printer and the off-line finishing device, including options installed thereon, and a means for receiving data pertaining to a job ticket that includes finishing specifics. The claim further recites that the print server includes a sorting means for separating finishing specifics included in the received job ticket "into those to be performed by the printer and those to be performed by the finishing device." The claimed print server further includes a means for setting parameters for finishing specifics in the printer, as separated by the sorting means and assigned to the printer. Finally, the print server includes a means for creating a finishing device job ticket that includes the finishing specifics separated by the sorting means and assigned to the finishing device. The crux of the issue to be decided on this review is whether the Hansen patent discloses a sorting means and a finishing device job ticket creating means, as recited in the claims.

In rejecting claim 1, the final Office Action states that the Hansen patent discloses a sorting means, with reference to column 7, lines 30-42. Referring thereto, the patent states that the print server performs processes that include spooling and queuing jobs, directing the jobs to specific production output devices based on the attributes of the print job, and load balancing jobs among the various production output devices. Thus, the Hansen patent

discloses that the print server functions to sort the various *jobs* among the production output devices. This type of sorting is not the same as that which is recited in the claims.

Specifically, claim 1 recites "sorting means for . . . separating the finishing specifics included in the job ticket . . . into those to be performed by the printer and those to be performed by the finishing device." Thus, the finishing information within a received job ticket is separated into two parts, namely those that can be performed on-line by the printer, and those that must be performed off-line by the finishing device.

The Hansen patent does not disclose this type of sorting operation. Rather, in performing its function of directing jobs to specific production output devices, it treats each job as a whole. For instance, the first job will be directed to a first output device, the next job will be directed to another output device, the third job directed to a third output device, and so on. The patent does not teach that the finishing specifics "included in the job ticket" are separated into those to be performed by a printer and those to be performed by an off-line finishing device.

This distinction is best exemplified by the passage at column 11, lines 53-63. As stated therein, when a production output device 122 receives a file for printing, it interprets the instructions to implement a desired feature. "For page features which the current device 122 cannot handle, the device 122 can signal the operator that manual intervention is required. . . . This may include instructing the operator to remove partially finished documents and transfer them to a binding machine. . . ." From this passage, it can be seen that the print server sends the entire print job to an output device. It is then up to that output device, and not the print server, to recognize which functions it is capable of performing, and those which must be performed by a different device.

The issue here is not whether the Hansen patent discloses a print server having a sorting means, per se. Rather, the question is whether the print server performs the specific function recited in the claim, namely "separating the finishing specifics included in the job ticket . . . into those to be performed by the printer and those to be performed by the finishing device." In view of the foregoing discussion, it can be seen that the Hansen patent does not disclose this claimed feature. To the extent that there is separation of

finishing specifics, that separation occurs at the output device, e.g. printer, not at the print server.

A second claimed feature that is not disclosed by the Hansen patent is a means for creating a finishing device job ticket that includes the finishing specifics "separated by the sorting means and assigned to the finishing device." In rejecting claim 1, the Office Action refers to the Hansen patent at column 9, lines 20-28, as allegedly disclosing this feature. This portion of the patent discusses workflow management software that integrates applications, to manage production printing workflow, including the creating and manipulation of job tickets. However, there is no disclosure of the creation of a *finishing device job ticket* as recited in the claim. Specifically, the Hansen patent does not disclose the creation of a job ticket that includes finishing specifics "separated by the sorting means" and assigned to the finishing device. Since, as discussed above, the Hansen patent does not disclose that the print server includes a sorting means that distinguishes between finishing operations to be performed by the on-line printer and those to be performed by the off-line finishing device, it cannot be interpreted to disclose the creation of a job ticket that includes finishing specifics "separated by the sorting means and assigned to the finishing device." The generic reference to the creation of job tickets does not suggest the claimed subject matter to a person of ordinary skill in the art, either explicitly or inherently.

The requirement for a rejection under 35 U.S.C. § 102 is set forth in MPEP §2131, "To anticipate a claim, the reference must teach every element of the claim." As demonstrated above, the Hansen patent fails to meet this requirement, since it does not teach at least two of the elements recited in claim 1. For the same reasons, it fails to anticipate each of the other independent claims. Specifically, claim 4 recites a sorting means and a creating means of the type discussed above in connection with claim 1. Claim 7 recites a computer program that performs the functions of separating the finishing specifics and creating data for a finishing device job ticket, and claims 10 and 13 recite a processor that performs these functions.
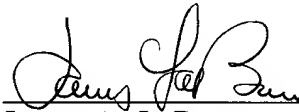
In view of the foregoing, the final Office Action does not create a record that is appropriate for appeal. While it points to generic disclosures of a sorting means and job ticket creation in the Hansen patent, it does not demonstrate where that patent discloses the

specific types of sorting means and finishing device job ticket creating means of the types recited in the claims. Withdrawal of the rejection under 35 U.S.C. §102 is submitted to be in order.

Since the rejections under 35 U.S.C. §103 are dependent upon the rejection under 35 U.S.C. §102, they also fail to comply with the requirement that the references disclose all of the features recited in the claims.

Respectfully submitted,
BUCHANAN INGERSOLL PC

Date: ___May 8, 2006___   By: _____

James A. LaBarre
Registration No. 28,632

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

VA 863325.1